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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,389	04/30/2001	Gordon R. Nuttall	10003837-1	2738

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HEWLETT-PACKARD COMPANY
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P.O. Box 272400
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EXAMINER

WORKU, NEGUSSIE

ART UNIT	PAPER NUMBER
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2625

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/845,389	Applicant(s) NUTTALL ET AL.	
	Examiner Negussie Worku	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to the arguments

1. This Office action is in response to amendment filed 05/23/07, Applicant's arguments with respect to claims 1, 13 and 19, has been carefully reviewed and found persuasive, and therefore, the prior arts used in the last office action under U.S.C.102 (e) has been withdrawn.

However, upon further consideration applicant's amendment necessitated the new ground(s) of rejection under U.S.C. (103(a), as presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dourish (USP 6,950,982), in view of Kondoh et al. (USP 6,968,058)

With respect to claim 1, Dourish teaches or discloses an image data capture device (a portable document reader of fig 1) for editing captured image data, col.2, lines 28-40) comprising: at least one image data capture element (mechanism 36 of fig 3, scans document 38, col.3, lines 38-40);

Although Dourish^h teaches an image data processor (electronic device 12, having a processing capability, which allow user to view a document 14 of fig 1, col.2, lines 65-67), Dourish^h fails to teach an image data processor for generating image files from image data acquired by said capture element and modifying said generated image file; and a user data entry device for enabling a user to modify said generated image files, wherein said at least said one image data capture element, said image data processor, and said user data entry device are disposed within a portable container.

Kondoh (058) in the same area of digital camera system,(as shown in fig 1) for generating and modifying detected data, teaches an image data processor (signal processor 5 of fig 13 for generating image files from image data acquired by said capture element (image pick up device 3); and a user data entry device (mode selection unit 31 of fig 3) for enabling a user to modify said generated image files, (col. 6, lines5-15) wherein said at least said one image data capture element, (2 of fig 3) said image data processor, (5 of fig 3) and said user data entry device (mode selection unit 31 of fig 3, are disposed within a portable container (camera 102 of fig 3, *as shown in fig 3, camera 302, which includes a processing capability for scanned document by image*

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pick up unit 2, for further processing by [signal processor 31 of fig 3], and data entry device input device (a mode selection 31 of fig 3 such as [may be an electronic pen, keyboard or stylus, or touch button, col.4, lines 40-65] are disposed within a portable document reader [digital camera 102 of fig 3]).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the imaging apparatus of Dourish (982) to include: an image data processor for generating image files from image data acquired by said capture element and modifying said generated image file; and a user data entry device for enabling a user to modify said generated image files, wherein said at least said one image data capture element, said image data processor, and said user data entry device are disposed within a portable container.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the imaging device of Dourish (982) by the teaching of Kondoh (058) for the purpose of obtaining a device that having a performance of both processing, editing, and storing the generated data within the device, that might increase efficiency and reduce the complicity and the price of the device.

With respect to claim 2, Dourish teaches or discloses an image data capture device (fig 1) wherein said image data capture element (annotation activation mechanism 36, scan document 38, see col.3, lines 38-40) is included in a digital camera, col.6, lines 3-2, and scanner 36 can be a CCD camera col.3, lines 38-40).

With respect to claim 3, Dourish teaches or discloses an image data capture device (fig 1) wherein said image data capture element (annotation activation mechanism 36, scan document 38, see col.3, lines 38-40) is included in a scanner, (scanner 36 of fig 3, col.3, lines 38-40).

With respect to claim 4, Dourish teaches or discloses the device (fig 1), wherein said user data entry device (electronic device 12 of fig 1, which allows user to view document 14, and which includes same manner of input device 16 such as a mouse, stylus, electronic pen etc.), comprises a pressure-sensitive tablet (as shown in 1, a display 10 having sensitive table, where annotation on document 14 is performed).

With respect to claim 5, Dourish discloses the device (fig), wherein said user data entry device (electronic device 12 of fig 1, which allows user to view document 14, and which includes same manner of input device 16 such as a mouse, stylus, electronic pen etc.), comprises an electro-magnetically coupled pen and writing surface (memo 14 is written by means input device [pen] on display 10 [a writing surface] as shown in fig 1).

With respect to claim 6, Dourish teaches or discloses the device (fig 1), wherein said user data entry device (16 of fig 1) comprises means for entering text annotation data into said generated image files (by in put device 16, which can be a stylus or electronic pen, col.2, lines 39-43).

With respect to claim 7, Dourish teaches or discloses the device (fig 1), wherein said user data entry device (16 of fig 1, such as keyboard and pen as shown in fig 1) comprises means (stylus or electronic pen, 16 of fig1) for entering graphical annotation data into said generated image files, (col. 2, lines 51-55).

With respect to claim 8, Dourish discloses the device (fig 1), further comprising means (input means 16 of fig 1) for entering image file processing instructions to said device (electronic memo processing 12 of fig 1).

With respect to claim 9, Dourish discloses the device (electronic memo processing device 12 of fig 1), comprising means (image memo processing device of fig 1) for converting handwritten user entries employing said user data entry device (16 of fig 1) into machine recognizable, (col.2, lines 52-55).

With respect to claim 10, Dourish discloses the device (electronic memo processing of fig 1), wherein said user data entry device 16 of fig 1) enables superimposition of user data entry on a display of an image file of said generated image files, (electronic memo processing apparatus 12 of fig 1, having input device 16 of fig 1, such as keyboard, pen or mouse can be used as a user data entry device that gives instruction to a device, as shown in 12 of fig 1).

With respect to claim 11, Dourish discloses the device (electronic memo processing 12 of fig 1), wherein said user data entry device enables annotation of said generated image files by direction, (electronic memo processing apparatus 12 of fig 1, can be a keyboard or electronic pen are used as means entering image processing gives instruction to device shown in fig 1).

With respect to claim 12, Dourish discloses the device (electronic memo processing of fig 1), further comprising: a communication interface (user interface 62 of fig 6)) for coupling said device to a network, (WEB 82 of fig 6, col.col.5, lines 29-30, and col.6, lines 1-5)

With respect to claim 13, Although Dourish teaches an image data processor (electronic device 12, having a processing capability, which allow user to view a document 14 of fig 1, col.2, lines 65-67), Dourish fails to teach capturing image data within said image capture device, element; receiving user-entered data in connection with selected captured ones of said image data; annotating said selected ones of said captured image data with said received user-entered data; and performing said steps of capturing, receiving, and annotating within a portable assembly.

Kondoh (058) in the same area of digital camera system,(as shown in fig 1) for generating and modifying detected data, teaches capturing image data within said image capture device element (2 of fig 3); receiving user-entered data in connection with selected captured ones of said image data (mode selection 31 of fig 3); annotating

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said selected ones of said captured image data with said received user-entered data; and performing said steps of capturing, receiving, and annotating within a portable assembly. device (mode selection unit 31 of fig 3, are disposed within a portable container, (camera 102 of fig 3, as shown in fig 3, camera 302, which includes a processing capability for scanned document by image pick up unit 2, for further processing by [signal processor 31 of fig 3], and data entry device input device (a mode selection 31 of fig 3 such as [may be an electronic pen, keyboard or stylus, or touch button, col.4, lines 40-65] are disposed within a portable document reader [digital camera 102 of fig 3]).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the imaging apparatus of Dourish (982) to include: an image data processor for generating image files from image data acquired by said capture element and modifying said generated image file; and a user data entry device for enabling a user to modify said generated image files, wherein said at least said one image data capture element, said image data processor, and said user data entry device are disposed within a portable container.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the imaging device of Dourish (982) by the teaching of Kondoh (058) for the purpose of obtaining a device that having a performance of both processing, editing, and storing the generated data within the device, that might increase efficiency and reduce the complicity and the price of the device.

With respect to claim 14, Dourish teaches or discloses the method (shown in fig 1) comprising the further step of: providing a network interface (interface 62 of fig 6, to a WEB 82 of fig 6) within said portable assembly (with in the electronic memo processing device of fig 1).

With respect to claim 15, Dourish teaches discloses the method (shown in fig 1-5), wherein said annotating step (step of fig 5), comprises the steps of: displaying a first image file of selected captured image data (display unit 10- fig 1, displaying a captured image data read by document reading unit 36 of fig 3, see steps 42-58 of fig 5); superimposing said user-entered data (as shown in fig 1, memo 14, annotation on document 14, on said displayed device 10 of fig 1, for updating); and providing a continuously updated display of said first image file as modified by said user-entered data, (by inputting means 16, user can update data on memo 14 of fig 1).

With respect to claim 16, Dourish teaches or discloses the method (shown in fig 1-5), further comprising the step of: electronically mailing said annotated selected ones of said at least one image files to at least one recipient, said recipient specified in said annotating step, see (col.6, lines 62-67)

With respect to claim 17, Dourish teaches or discloses the method (shown in fig 1), further comprising the step (see step 42-52 of fig 5) of: saving said annotated selected ones of said image data; see (col.12, lines 42-45).

With respect to claim 18, Dourish discloses the method (shown in fig 1), wherein said step of saving comprises the step of: transmitting said annotated selected ones of said image data over a public network to a node on said public network, (a communication interface 62 of fig 6, to WEB 82 of fig 6, col.5, lines 27-30).

With respect to claim 19, Dourish discloses the optical scanner (scanner 12 fig 1), comprising: means for capturing image data (scanner 36 of fig 3); means for displaying selected image data (display unit 10 of fig 1); means for receiving user-entered data in connection with said selected image data (electronic memo display unit 10, determine memo type 14 of fig 1); means for superimposing said received user-entered data on said displayed selected image data (selected image data graphic or text displayed on the memo display unit 10 for further editing or annotation on document 14 of fig 1, col.2, lines 5-55); and means (electronic memo processing device 12 of fig 1), for annotating said displayed selected image data with said superimposed received user-entered data, see (step 42-52 of fig 5).

Dourish fails to teach optical scanner is a portable assembly, Kondoh (058) in the same area of digital camera system,(as shown in fig 1) a scanner is a portable assembly, (camera 102 of fig 3, as shown in fig 3, camera 302, which includes a

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processing capability for scanned document by image pick up unit 2, for further processing by [signal processor 31 of fig 3], and data entry device input device (a mode selection 31 of fig 3 such as [may be an electronic pen, keyboard or stylus, or touch button, col.4, lines 40-65] are disposed within a portable document reader [digital camera 102 of fig 3]).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the imaging apparatus of Dourish (982) to include: an optical scanner is a portable assembly

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the imaging device of Dourish (982) by the teaching of Kondoh (058) for the purpose of obtaining a device that having a performance of both processing, editing, and storing the generated data within the device, that might increase efficiency and reduce the complicity and the price of the device.

With respect to claim 20, Dourish teaches or discloses the optical scanner (scanner 12 of fig 1), further comprising: a communication interface (user interface 62 of fig 6) for enabling said optical scanner (36 of fig 63) to communicate over a data communication network, (remote terminal or a server over a network, such as WEB 82 of fig 6) or under at least partial control of said means for annotating, see (col.6, lines 45-50).

With respect to claim 21, Dourish discloses the optical scanner (fig 1) wherein the means for receiving comprises means for receiving handwritten graphical data

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(electronics memo processing 12 of fig 1, memo display unit 10 of fig 1) received hand written graphic data, see (col.2, lines 51-54).

Response to the arguments

4. This Office action is in response to amendment filed 05/23/07, Applicant's arguments with respect to claims 1, 13 and 19, has been carefully reviewed and found persuasive, and therefore, the prior arts used in the last office action under U.S.C.102 (e) has been withdrawn.

However, upon further consideration applicant's amendment necessitated the new ground(s) of rejection under U.S.C. (103(a), as presented in this Office action.

Further, to applicant's arguments with respect to above indicated claims as discussed on page 7 and 8, the new ground of rejection has been submitted to address the claimed limitation that the prior art did not disclose in the last Office action.

The deficiency of the prior art used in the last rejection as indicted new ground of rejection fully discloses the claimed limitation of claims 1-21 in combination with newly cited reference, and therefore, Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Negussie Worku whose telephone number is 571-272-7472. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung Moe can be reached on 571-272-7314. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Negussie Worku
7/24/07

Aung S. Moe
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7/30/07